REMARKS

Claims 1-29 were originally submitted.

No claims are canceled.

Claims 30-39 have been added in a previous response.

Claims 1, 3-4, 7-8, 10, 15, 21-30, 32-33, 36, and 39 have been previously amended.

The declaration filed 6/17/2003 under 37 CFR 1.131 has been accepted to overcome the cited reference U.S. Patent 6,219,653 to O'Neill et al.

Examiner Douglas Blair had previously indicated that the current claim listing beginning on page 2 of this paper as overcoming the rejections presented in the Office Action of November 13, 2003.

Claims 1-39 remain in this application.

Examiner Interview

An Examiner Interview was conducted by telephone on August 24, 2004 with Examiner Douglas Blair and Emmanuel Rivera (please note in the Interview Summary provided by Examiner Blair and mailed on 9/7/04, the interview date was erroneously identified as April 24, 2004).

Mr. Rivera presented that the Microsoft® trademark is properly referenced in the specification. Agreement was reached as to this issue.

Mr. Rivera asked what information would be relevant as to information requested by the Office. Mr. Rivera presented that the drawings showed the features of what is specified in the claims and that the specification is sufficient to meet the enablement requirement. Furthermore, a discussion took place as to the rejections in the present Office Action that are based on earlier cited references.

No agreement was reached after the Interview as to any allowed or allowable claims.

Double Patenting

Claims 1-39 are rejected under the nonstatutory judicially created doctrine of double patenting over claims 1-33 of U.S. Patent 6,052,710 to Saliba et al (Saliba) filed on June 28, 1996 and issued on April 18, 2000. The Office presents that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be filed to overcome the rejection and that a registered attorney or agent of record may sign such a terminal disclaimer. A signed terminal disclaimer is submitted with this response.

Specification

As to the Microsoft® trademark, the Office points out the proprietary nature of trademarks and that trademark should be capitalized and accompanied by the generic terminology. As discussed during the Examiner interview of August 24th, the use of the Microsoft® trademark is acceptable as written in the specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. "[T]he process of automatically configuring a new trading relationship with a new trading partner using configuration details must be shown or the feature(s) canceled from the claim(s)." Applicants respectfully traverse this objection. As discussed below, in answer to the 35 U.S.C. §112 rejection, automatically configuring a new trading relationship

is adequately described in the specification with reference to features as illustrated in the drawings.

Applicants have found a typographical error in Fig. 1. "TP Records" of "First Trading Partner Computer System 22(1)" is erroneously identified as "50(2)" and should be labeled as "50(1)". A corrected replacement sheet is provided as an attachment to this response.

Request for Information

The Office has requested information as to:

- Internet Information Server (IIS) from the Microsoft Corporation;

- Site Server, Commerce Edition from the Microsoft Corporation;

- Commerce Interchange Pipeline (CIP) from Microsoft Corporation; and

- Commerce Interchange Pipeline Manager (CIPM) from the Microsoft Corporation.

During the interview, Examiner Blair indicated such information may be a general description of each of the products. Such descriptions are provided as an attachment to this response.

It is noted that this is the first time such a request for information has been made by the Office for this application. Applicants find this out of the ordinary considering the prosecution history of the application:

The present application was filed on April 5, 1999. An Office Action was sent April 25, 2002. An Office Action was sent September 16, 2002. A Final Office Action was sent April 8, 2003. An Office Action was sent July 18, 2003. A Final Office Action was sent November 13, 2003. Responses to each of the

Office Actions were filed. It is only now in this recent Office Action of May 3, 2004 that such a request has been made.

35 U.S.C. §112

Claims 1, 4, 8, 10, 15, 22, 27, 28, 29, 30, 33, 39 are rejected under 35 U.S.C. §112 as failing to comply with the enablement requirement. Like the request for information above, Applicants find this rejection out of the ordinary at this point of prosecution of the application, considering that the five prior Office Actions had not raised a §112 rejection. It seems that the Office found the specification enabling in the prior Office Actions in raising rejections based on §102 and §103.

In any event, Applicants respectfully traverse the §112 rejection.

The Office presents that "there is nothing within the applicant's specification that provides any guidance for one skilled in the art to create a system for automatically creating a trading relationship, placing an undo burden of experimentation on anyone trying to implement the applicants claimed invention."

Applicants disagree, and present that the specification clearly defines the metes and bounds of the claimed invention. The drawings in combination with the written description plainly describe the invention to a person skilled in the art. For example, with respect to the creation of a trading relationship, the specification states:

> The configuration details are entered manually by a user/operator of the trading partner. The configuration details include business information as trading partner name, mailing address, Web site address, and email address. The configuration details also include system information such as the various network and data

communication protocol(s) supported by the computer systems and the type of software being run on each server. The configuration details might further include security information, such as cryptographic capabilities, digital certificates, and so forth.

Specification, page 5, lines 4-11.

One or more pages 48(1), 48(2) hold a copy of the configuration details 44(1)', 44(2)' stored in the CIPM databases 40(1), 40(2). That is, the configuration details that were entered manually are posted to the trading partner's Web site (or another designated site) at a URL (universal resource locator) that is publicly accessible. As a result, when two partners create a trading relationship, each trading partner visits the other's Web site using the given URLs and download the Web pages 48(1), 48(2) with the configuration details 44(1)', 44(2)' for use in automated configuration of the trading relationship. In one implementation, the CIPM programs 38(1), 38(2) create trading partner records 50(1), 50(2) and automatically populate them with the other trading partner's configuration details.

Specification, page 5, line 19 to page 6, line 4.

In summary, configuration details are entered manually by operators of trading partners. The entered (recorded) configurations details are posted to a Web site (the trading partner's or otherwise) as identified by a URL. When two partners create a trading relationship, each trading partner visits the other's Web site as identified by the URL. The respective Web pages with the configurations details are then downloaded to automatically configure the trading relationship. In other words, no manual recording is necessary since each trading partner is able to programmatically download (i.e., automatically configure) the needed information to form a trading relationship.

The Office presents "there is no definition as to what a trading relationship is in the context of the applicant's invention". Again, Applicants disagree.

The specification particularly states that "[t]he trading relationship governs how the computer systems 22(1) and 22(2) connect and communicate with one another". Specification page 4, lines 1-3. Configuration details describe information as to a trading relationship, and the configuration details are mutually provided to the trading partners.

The Office presents "[t]here are no details provided on how the first trading partners computer interfaces the second trading partner's computer to 'automatically' create and configure a trading relationship".

As discussed above, each trading partner visits the other's Web site as identified by a URL to access the other trading partner's configuration details. The interfacing is performed using a "network 24, such as the Internet or other wide area network, interconnects the computer systems 22(1) and 22(2)". Specification page 3, lines 23-24.

Furthermore, the Office presents "applicant's specification fails to provide any direction for one to implement a system establishing a trading relationship automatically".

This issue was discussed above as to the Office's first issue as to lack of guidance "to create a system for automatically creating a trading relationship".

Accordingly, the §112 rejection of claims 1, 4, 8, 10, 15, 22, 27, 28, 29, 30, 33, 39 is improper, and should be withdrawn.

35 U.S.C. §103

Claims 1, 3, 8, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,812,669 to Jenkins et al (Jenkins). Applicants respectfully traverse the rejection.

As discussed in the response to the Office Action of July 18, 2003, Jenkins teaches a method and system that is based on two parties that have *an established trading agreement*, and communicate with one another using mutually known communication protocols.

Independent claim 1 recites in part "retrieving configuration details associated with a new trading partner from a remote site; and automatically configuring a new trading relationship with the new trading partner using the configuration details."

The Office admits that Jenkins does not teach establishing a relationship with a new trading partner, and relies on the assumption that it would have been obvious for someone of ordinary skill in the art to combine the teachings of Jenkins with the idea of trading with a new partner because at some point in time any trading partner has to be new.

Applicants do not disagree with the Office's position that at some point a trading partner has to be new. Since Jenkins teaches that the two parties have an established trading relationship, it would be counterintuitive to establish a new trading partnership between the established trading parties. Further, there is no teaching in Jenkins or an assumption as to how that new trading relationship would be created.

Applicants respectfully request that the §103 rejection of claim 1 be withdrawn.

Dependent claim 3 depends from and comprises all the elements of claim 1. As such, dependent claim 3 is allowable by virtue of its dependency on base claim 1. Applicants respectfully request that the §103 rejection of claim 3 be withdrawn.

Independent claim 8 is rejected on the same grounds as claims 1 and 3. Applicants assert the argument presented in support of claim 1, in support of claim 8. Applicants respectfully request that the §103 rejection of claim 8 be withdrawn.

Dependent claim 9 depends from and comprises all the elements of claim 8. As such, dependent claim 9 is allowable by virtue of its dependency on base claim 8. Applicants respectfully request that the §103 rejection of claim 9 be withdrawn.

Independent claim 30 is rejected on the same grounds as claim 1. Applicants assert the argument presented in support of claim 1, in support of claim 30. Applicants respectfully request that the §103 rejection of claim 30 be withdrawn.

Dependent claim 32 depends from and comprises all the elements of claim 30. As such, dependent claim 32 is allowable by virtue of its dependency on base claim 30. Applicants respectfully request that the §103 rejection of claim 32 be withdrawn.

Claims 1-11, 13-17 and 19-29 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent 6,490,567 to Gregory et al (Gregory). Applicants respectfully traverse the rejection.

As discussed in the response to Office Action of July 18, 2003, Gregory teaches three-party electronic commerce transactions involving a commerce server party, a merchant party, and a purchaser party. The commerce server party stores purchaser party profile data and merchant party content summaries on a commerce database.

The merchant party may edit the products it makes available to the purchaser by searching the commerce database of the commerce server. The purchaser party may browse and search for product and merchant (party) information through the commerce server, and is provided with more detailed information stored at a separate merchant content server. The purchaser selects products and a purchase order is sent to the commerce server. The commerce server initiates the settlement of accounts between the merchant and purchaser (the two parties), and initiates order fulfillment.

The methods and systems taught by Gregory are constructed in order to allocate the tasks of commerce transaction functionality to the commerce server party, and thus freeing up the merchant party from performing commerce transactions with the purchaser party. In other words, the merchant and purchaser parties never directly enter into a trading relationship, and have no need to know one another's configuration details to establish a trading relationship.

Gregory teaches how information is made available at the commerce server party to the purchaser; however, such information is limited to products offered by the merchant; information regarding the merchant's return policy; forms of payment accepted by the merchant; and information as to ordering products.

Independent claim 1 recites in part "retrieving configuration details associated with a new trading partner from a remote site; and automatically

configuring a new trading relationship with the new trading partner using the configuration details."

The Office states that that "[a]s to claim 1, Gregory teaches ... retrieving configuration details associated with a potential trading partner from a remote site (col. 8, lines 36-52), and automatically configuring a trading relationship with the potential trading partner using the configuration details (col. 8, lines 53-67); however, Gregory does not explicitly teach establishing a relationship with a new trading partner".

The information taught in Gregory is merchant information, not "configuration details associated with a new trading partner". Configuration details comprise such information as a trading partner name, mailing address, Web site address, email, network and data communication protocol(s), cryptographic capabilities, and digital certificates. Configurations details are not taught or suggested by Gregory. The merchant information taught by Gregory is limited to products offered by the merchant; information regarding the merchant's return policy; forms of payment accepted by the merchant; and information as to ordering products.

Gregory teaches purchase of a product from a website, then using a commerce server to perform transactional functions to perform the purchase. As discussed above, Gregory does not teach or suggest configuring a trading relationship between the merchant and the purchaser, where the trading relationship provides for a network-based business exchange. Gregory specifically provides that the commerce or service provider perform the tasks of commerce transactions. See Gregory, col. 2 lines 16-27. Gregory teaches that transaction functionality is performed by a separate third party, the commerce server. A direct

trading relationship is never established between the merchant party and the purchaser party. Therefore, the merchant party and the purchaser party never directly enter into a trading relationship, and no need exists for "automatically configuring a trading relationship with the new trading partner".

Gregory fails to teach or suggest the recited elements even when combined with the assumption the Office makes that it would have been obvious for someone of ordinary skill in the art to combine the teachings of Gregory with the idea of trading with a new partner because at some point in time any trading partner has to be new.

Applicants respectfully request that the §103 rejection of claim 1 be withdrawn.

Dependent claims 2 and 3 depend from and comprise all the elements of claim 1. As such, dependent claims 2 and 3 are allowable by virtue of their dependency on base claim 1. Applicants respectfully request that the §103 rejection of claims 2 and 3 be withdrawn.

Independent claim 4 recites in part "collecting configuration details associated with a new trading partner participating in the commerce trading system; and publishing the configuration details to a Web site".

The Office states that that "[a]s to claim 4, Gregory teaches ... *collecting configuration details* associated with a trading partner ... ; and publishing the configuration details to a Website (col. 8, lines 26-35); however, Gregory does not explicitly teach establishing a relationship with a new trading partner".

As discussed above in support of claim 1, Gregory teaches the information to a purchaser is limited to products offered by the merchant; information regarding the merchant's return policy; forms of payment accepted by the

merchant; and information as to ordering products. Such information is merchant content information and not "configuration details associated with a trading partner", and is not used in the creation of a trading relationship. Configuration details comprise such information as a trading partner name, mailing address, Web site address, email, network and data communication protocol(s), cryptographic capabilities, and digital certificates. Configurations details are not taught or suggested by Gregory.

The Office assumes that it would have been obvious to one of ordinary skill in Computer Networking to combine the teachings of Gregory regarding the establishing of a trading relationship with the idea of trading with a new partner because at some point in time any trading partner has to be new.

As discussed are not taught or suggested by Gregory. Therefore it would not have been obvious to combine the "merchant content information" as taught by Gregory with the assumption that the Office makes.

Applicants respectfully request that the §103 rejection of claim 4 be withdrawn.

Dependent claims 5, 6, and 7 depend from and comprise all the elements of claim 4. As such, dependent claims 5, 6, and 7 are allowable by virtue of their dependency on base claim 4. Applicants respectfully request that the §103 rejection of claims 5, 6, and 7 be withdrawn.

Independent claim 8 is rejected on the same grounds as claims 1 and 3. Applicants assert the argument presented in support of claims 1 and 3, in support of claim 8. Applicants respectfully request that the §103 rejection of claim 8 be withdrawn.

Dependent claim 9 depends from and comprises all the elements of claim 8. As such, dependent claim 9 is allowable by virtue of its dependency on base claim 8. Applicants respectfully request that the §103 rejection of claim 9 be withdrawn.

Independent claim 10 is rejected on the same grounds as claim 1. Applicants assert the argument presented in support of claim 1, in support of claim 10. Applicants respectfully request that the §103 rejection of claim 10 be withdrawn.

Dependent claims 11, 13, and 14 depend from and comprise all the elements of claim 10. As such, dependent claims 11, 13, and 14 are allowable by virtue of their dependency on base claim 10. Applicants respectfully request that the §103 rejection of claims 11, 13, and 14 be withdrawn.

Independent claim 15 is rejected on the same grounds as claim 1. Applicants assert the argument presented in support of claim 1, in support of claim 10.

Claim 15 further recites in part "the first computer system collecting configuration details associated with the first trading partner and publish the configuration details to the Web site".

The Office states "Gregory teaches ... the first computer system collecting configuration details associated with the first trading partner and publish the configuration details to the Web site (col. 6, lines 37-54)".

As discussed above, Gregory teaches a merchant requesting a summary of products from the commerce database of the commerce server. The product summary does not include configuration details as described above, but is limited

only to the products offered by the particular merchant (merchant content information).

Applicants respectfully request that the §103 rejection of claim 15 be withdrawn.

Dependent claims 16, 17, and 19-21 depend from and comprise all the elements of claim 15. As such, dependent claims 16, 17, and 19-21 are allowable by virtue of their dependency on base claim 15. Applicants respectfully request that the §103 rejection of claims 16, 17, and 19-21 be withdrawn.

Independent claim 22 is rejected on the same grounds as claim 15. Applicants assert the argument presented in support of claim 15, in support of claim 22. Applicants respectfully request that the §103 rejection of claim 22 be withdrawn.

Dependent claims 23-26 depend from and comprise all the elements of claim 22. As such, dependent claims 23-26 are allowable by virtue of their dependency on base claim 22. Applicants respectfully request that the §103 rejection of claims 23-26 be withdrawn.

Independent claim 27 is rejected on the same grounds as claim 15. Applicants assert the argument presented in support of claim 15, in support of claim 27. Applicants respectfully request that the §103 rejection of claim 27 be withdrawn.

Independent claim 28 is rejected on the same grounds as claim 15. Applicants assert the argument presented in support of claim 1, in support of claim 28. Applicants respectfully request that the §103 rejection of claim 28 be withdrawn.

Independent claim 29 is rejected on the same grounds as claim 15. Applicants assert the argument presented in support of claim 15, in support of claim 29. Applicants respectfully request that the §103 rejection of claim 29 be withdrawn.

Dependent claims 31, 37, and 38 are rejected on the same grounds as claims 6, 9, 13, 19, 20, 24, and 25. Applicants assert the arguments presented in support of claims 6, 9, 13, 19, 20, 24, and 25, in support of claims 31, 37, and 38. Applicants respectfully request that the §103 rejection of claims 31, 37, and 38 be withdrawn.

Claims 12 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gregory in view of U.S. Patent 6,466,490 to Mills et al (Mills). Applicants respectfully traverse the rejection.

Dependent claim 12 depends from claim 10 and incorporates the features of claim 10. As such claim 12 requires "collecting configuration details associated with the first trading partner; publishing the configuration details to a Web site; creating, at the second trading partner, a trading partner record for the first trading partner; retrieving the configuration details associated with the first trading partner from the Web site; and populating the trading partner record with the configuration details associated with the first trading partner". Claim 12 further recites "publishing the configuration details in XML format".

The Examiner states "[a]s to claim 12, Gregory teaches a method of publishing configuration details"; however, has not pointed out where in Gregory such element is described.

Claim 12 requires the element of "collecting configuration details associated with the first trading partner".

Gregory does not teach or suggest collecting configuration details associated with the first trading partner. Gregory shows a purchaser visiting a website to browse and purchase products. A purchase may be made and processed by a commerce server. However, configuration details that allow a trading relationship to be established are not collected. The trading record that the Examiner asserts is created in Gregory is a purchase report that includes purchases made by the purchaser from the merchant. Gregory, col. 11, lines 13-25. The purchase orders in the purchase report are not configuration details that allow a trading relationship to be established between the parties. Therefore, if configuration details are not collected in the systems and methods described in Gregory, it follows that Gregory fails to teach or suggest the other elements of "publishing the configuration details to a Web site; creating, at the second trading partner, a trading partner record for the first trading partner; retrieving the configuration details associated with the first trading partner from the Web site; and populating the trading partner record with the configuration details associated with the first trading partner".

The Office admits that "Gregory does not teach a method of publishing configurations details in an XML format" and relies on Mills as teaching "the publishing of trading configuration details in an XML format (col. 16, lines 13-55, and col. 17, lines 1-10). However, Mills provides no suggestion of "collecting configuration details associated with the first trading partner".

The combination of Gregory and Mills do not teach every element of claim 12, and the rejection of claim 12 is therefore improper. Accordingly, Applicants respectfully request that the §103 rejection of claim 12 be withdrawn.

Dependent claim 18 is rejected on the same grounds as claim 12. Applicants assert the argument presented in support of claim 12, in support of claim 18. Applicants respectfully request that the §103 rejection of claim 18 be withdrawn.

Claims 31 and 33-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jenkins in view of Gregory. Applicants respectfully traverse the rejection.

The Office has provided the same arguments as presented in the Office Action of November 13, 2003. Paragraphs 37-44 of the present Office Action are the same as paragraphs 29-36 of the Office Action of November 13, 2003. The Office adds a subparagraph in paragraph 44 that "[i]t would have been obvious to one of ordinary skill in Computer Networking art at the time of invention to combine the teachings of Jenkins regarding establishment of a trading relationship with the idea of trading with a new partner because at some point in time any trading partner is new."

Applicants present the same arguments as presented in the response to the Office Action of November 13, 2003, in support of claims 31 and 33-39. Furthermore, as discussed above in support of claim 1, since Jenkins teaches that the two parties have an established trading relationship it would be counterintuitive to establish a new trading partnership between the established trading parties.

Therefore it would not have been obvious to combine Jenkins with the assumption that at some point in time any trading partner has to be new.

Applicants respectfully request that the §103 rejection of claims 31 and 33-39 be withdrawn.

CONCLUSION

All pending **claims 1-39** are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

Dated: __U/2/04__   By: _____

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